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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/521,950

03/09/2000

Sunao Tabata

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2947

22428

7590

08/13/2004

FOLEY AND LARDNER
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EXAMINER

BURLESON, MICHAEL L

ART UNIT

PAPER NUMBER

2626

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/521,950

Applicant(s)

TABATA ET AL.

Examiner

Michael Burleson

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 15-18 and 20 is/are allowed.
- 6) ☒ Claim(s) 4 is/are rejected.
- 7) ☒ Claim(s) 5-13 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2-4, 7</u> . | 6) <input type="checkbox"/> Other: ____. |

Response to Amendment

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claim 4 is rejected under 35 U.S.C. 102(e) as being anticipated by Oneda et al. US 6519052.

Regarding claim 4, Oneda et al. teaches color image data (column 6, lines 57-60). He also teaches of an image data compressor (12) (figure 1), which reads on a compression means for compression a color image signal. He teaches of an image data expander (16) (figure 1), which reads on a decoding means for decoding the image

signal compressed by the compression means. He also teaches of a selector (18) and an image converter (19). The selector (18) selects the compressed or non-compressed image to be inputted to the image converter where image processing takes place (column 7, lines 63-67, column 8, lines 1-10 and figure 1), which reads on image processing means for selectively executing image processing on the color image signal compressed by the compression means and then decoded by the decoding means, and image processing on a color image signal that has never been compressed.

1. Regarding claim 19, Oneda et al. teaches that the image data is input from an external image-input device, for example an image scanner (column 5, lines 36-37), which reads on a scanning means for scanning a document to provide the color image signal. He also teaches of a system controller (71), which controls the selector (18) (76g) (column 8, lines 1-10 and figure 1) and the image converter (19) (76h) (column 10, lines 60-67 and column 11, lines 1-8 and figure 1), which reads on control means for controlling operation of the image processing apparatus; a selector for providing, based on a control signal provided by the control means, the color image signal to one of the compression means and the image processing means.

Allowable Subject Matter

2. Claims 5-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 2626

1. Claims 1-3, 15-18 and 20 are allowed.
2. Regarding claim 1, the closest reference Tanio US 5726778 in view of Toda et al. US 6476924 fails to teach of a blacking processing means for adding a black component to the second color image signal to create a third color image signal and compressing the third color image signal on the basis of a frequency conversion system.
3. Regarding claim 15, the closest reference Tanio US 5726778 in view of Toda et al. US 6476924 fails to teach of a recognition means for recognizing the type of an image corresponding to a first color image signal that contains no black and a first blacking means for adding a black ratio to a second color image signal when the recognition means recognized the first color image signal indicates a letter image creating a third color image and a second blacking means for adding a second black ratio differing from the first black ratio and recognition means recognized the first color image signal indicates a photograph image creating a third color image.
4. Regarding claim 17, the closest reference Tanio US 5726778 in view of Toda et al. US 6476924 fails to teach of blacking means, on the basis of a first blacking system, for adding a black ratio to a second color image signal when the recognition means recognized the first color image signal indicates a letter image creating a third color image and a second blacking means, on the basis of a second blacking system different from the first, for adding a second black ratio differing from the first black ratio and recognition means recognized the first color image signal indicates a photograph image creating a third color image.

Conclusion

1. Any inquiry concerning this communication should be directed to Michael Burleson whose telephone number is (703) 305-8683 and fax number is (703) 746-3006. The examiner can normally be reached Monday thru Friday from 8:00 a.m. – 4:30p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached at (703) 305-4863

Michael Burleson
Patent Examiner
Art Unit 2626

MIb
July 10, 2004

MIb

MaDeLeine Nguyen

**MADELEINE NGUYEN
PATENT EXAMINER**

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